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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/467,293	12/17/99	TSUGITA	R 247/062

022249
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QM12/0425

EXAMINER	
MENDEZ,M	
ART UNIT	**PAPER NUMBER**
3763	2

DATE MAILED: 04/25/00

Pleas find below and/or attached an Office communication concerning this application or proc eding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/467,293	Applicant(s) TSUGITA ET AL.
	Examiner Manuel Mendez	Group Art Unit 3763

☐ Responsive to communication(s) filed on _____ .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *THREE* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-27* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-27* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-8 and 10-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabbay in view of Miller et al and Buckberg et al. The Gabbay patent discloses an elongate tubular member having a proximal end, a distal end, and a lumen therebetween, and an expandable occluder deployable from the distal region of the cannula. Gabbay does not disclose or suggest the insertion of a filter separately insertable through the elongate tubular member. It would have been obvious to modify Gabbay by substituting for any of the instruments inserted in lumens (2,3)

thereof, a filter as taught by Miller, et al., since Miller, et al., suggests that a filter enhances the capabilities of the tubular member by providing a filter that can be directly attached to the walls of a vessel.

In relation to claim 9, Gabbay does not disclose a cannula having a distal end that is straight. Buckberg, et al., discloses an antegrade cardioplegia cannula having a distal end that is straight. It would have been obvious to a person of ordinary skill in the art to modify Gabbay by substituting for the curved distal end thereof, a straight distal end as disclosed by Buckberg et al., since Buckberg et al. demonstrates that said straight cannula is a conventional design in the treatment of the heart, and therefore said modification to Gabbay must be considered as an obvious design alternative. In relation to the disclosed method claims, the references cited above, disclosed all the critical elements of the applicants invention. Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily performed the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. **In re king**, 231 USPQ 136 (Fed. Cir. 1986).

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Mendez whose telephone number is (703) 308-2221.

Manuel Antonio Mendez

April 23, 2000